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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962.

No. 929

G. LEBLANC CORPORATION,

Petitioner,

vs.

H. & A. SELMER, INC.,

Respondent.

RESPONDENT'S REPLY BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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THE ANTHONY WAYNE PRINTING COMPANY, CHICAGO

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INTRODUCTION.

At the very outset, a highly significant and pertinent question presents itself.

Is it within the policy and purpose of this Supreme Court to grant certiorari on questions which, regardless of how answered, are moot and not dispositive of the action?

The Petitioner here seeks a review of the Judgment of the Court of Appeals for the Seventh Circuit holding invalid claim 4 of Leblanc Patent No. 2,627,776 and claims 4, 5 and 6 of the reissue of that patent, No. Re. 23,725.

Two questions only are presented.

One relates to whether or not an alleged continuation-in-part application is entitled to the filing date of a predecessor application. Petitioner is hopeful of having this question answered in the affirmative and of thereby removing a bass clarinet, DX 18 (A. p. 440), as prior art. That clarinet was made and sold by Petitioner more than one year prior to the filing date of Leblanc Patent No. 2,627,776 in suit.

The other question relates to whether the permissive provision for intervening rights in the Patent Statute should be considered to be mandatory.

But the Court of Appeals held the claims in suit invalid for reasons not involved in these questions or their answers. On pages 6 and 7 of its decision the Court of Appeals held (310 F. 2d 453, Col. 2):

> "Our attention has been directed to defendant's chart, in evidence as defendant's Exhibit 2, showing views taken from the patent drawings of the Albert patent, the reissue patent in suit and the expired Leblanc patent. This further demonstrates to our satisfaction that the key manipulation of the specific mechanism of the patents in suit is disclosed in the Albert patent.
>
> We are led to conclude that in the patents in suit Leblanc relied upon his original concept in his expired Leblanc patent, the key manipulation from the Albert patent and the disclosure from Albert of how to alter the mechanism in his expired patent. We agree with defendant that Leblanc's claimed inventions in suit are at best an abortive attempt to extend the monopoly of the expired Leblanc patent."

Thus, the claims of the patents in suit were held invalid over the expired patents to Leblanc and Albert, not only upon the clarinet DX 18, as Petitioner erroneously implies.

Such holding of invalidity would still stand against Petitioner because it has not been presented by the two questions upon which the Petition is based.

Wherefore, the questions presented are moot: their consideration would not dispose of the action.

Petitioner's questions present nothing not fully considered and decided by the Trial Court and the Court of Appeals. There is no new question of law or policy presented requiring exposition by this Court, and nothing is presented within the purview of Rule 19, 1(b).

There is no basis for granting the Petition.

STATEMENT OF THE CASE.

This is an action for alleged infringement of claim 4 of Leblanc Patent No. 2,627,776 and claims 4, 5 and 6 of the reissue of that patent, Leblanc No. Re. 23,725.

The patents in suit relate to key mechanism for clarinets particularly with regard to the register, B-flat and F-sharp tone holes.

Reissue claims 5 and 6 were not in the original patent. Reissue claim 4 is admittedly not identical with claim 4 of the orginal patent.

Respondent defended on the grounds of invalidity, relying mainly on the expired Leblanc Patent No. 1,926,489 and the expired Albert Patent No. 1,529,567, non-infringement, and intervening rights.

The Trial Court held the claims in suit invalid on several grounds and not infringed, and further held that respondent had intervening rights as to the claims of the reissue patent. The Court of Appeals affirmed the Trial Court's decision (C. A. Dec. p. 17; 310 F. 2d 460) in the following language:

"In sum, we are in complete agreement with the dis-

position made of this case by the able district judge to whom it was submitted for trial.

For the foregoing reasons, the judgment of the district court appealed from herein in Nos. 13,232 and 13,233 is in all respects affirmed."

Petitioner here relies on the fiction, already fully considered by both the Trial Court and Court of Appeals, to the effect that it had been the practice for many years to provide a single register hole in soprano clarinets but not in alto or bass clarinets. Petitioner urges therefore that the expired Leblanc Patent No. 1,926,489 and the expired Albert Patent No. 1,529,567 are concerned with soprano clarinets.

Petitioner belied its own contention regarding the expired Leblanc patent by making and selling a bass clarinet with a single register hole, DX 18, which it admitted embodied the mechanism of the expired Leblanc patent (A. pp. 101-102; 161, 163).

As to the Albert patent, the patentee himself stated "This invention has for its object to provide a mechanism applicable to clarinets of all types," (A. p. 199).

Mr. Devoe C. De Ford relied on both the expired Leblanc and Albert patents to produce the accused bass clarinet (A. pp. 364-365).

There can be no mystery, as the Trial Court and Court of Appeals well understood, in using soprano clarinet mechanism on an alto or bass clarinet. All one need do is read some reference books. For example, a reference book "*Musical Instruments—Their History in Western Culture from The Stone Age to the Present*," by Karl Geiringer, translated by Bernard Miall, New York Oxford University Press, 1945. From pages 222 and 223:

"Bass Clarinet

Bass clarinets, an octave below the soprano clarinets, have been made since 1772, and have varied in shape.

However, the instrument first achieved importance in the 30's of the nineteenth century. In 1835, Meyerbeer introduced the bass clarinet in Les Huguenots, and in 1839 Adolphe Sax made a model which attracted attention by its efficiency and its beauty of tone. Since then the bass clarinet has been made in the straight form, or with the metallic bell turned upwards, *and with the same key mechanism as the soprano clarinet.* In the nineteenth century instruments in C, $B_\flat$ and A were in use. Today we are content with the bass clarinet in $B_\flat$. *It is scored in the treble clef* (compass e-g^3), the actual sound being a ninth deeper. Owing to the soft, expressive tone of the instrument, it seems even more fitted to form the bass of the wood-wind than the bassoon. It is also greatly esteemed as a solo instrument. Wagner, above all, has made use of its noble voice in passages of a peculiarly expressive character." (Emphasis supplied.)

ARGUMENT.

THE ORIGINAL PATENT IN SUIT WAS NOT PROPERLY A CONTINUATION-IN-PART OF THE EARLIER LEBLANC APPLICATION.

The application resulting in Leblanc Patent No. 2,627,776 in suit clearly was not a continuation-in-part of the Leblanc abandoned application Serial No. 742,966 (A. pp. 583-606; drawing in Petitioner's Brief p. 35). It is not entitled to the filing date of the abandoned applicaton.

Petitioner urges that the Leblanc bass clarinet, DX 18, was linked to the patents in suit by the abandoned application and therefore is not prior art. This, notwithstanding the fact that DX 18 admittedly embodied the mechanism of the expired Leblanc Patent No. 1,926,489, upon which the abandoned application was rejected.

Petitioner relies upon *Noradel Process Corp.* v. *J. P. Meyer & Co.*, 35 F. 2d 697, 701 (CCA2), wherein the abandoned application had sufficient disclosure to support the patented claims in the later filed continuation-in-part application. Similar support does not exist here. That decision is irrelevant.

The law here applicable is found in *Good Roads Co., Inc.* v. *Charles Hvass & Co. Inc.*, 70 F. 2d 625, 627 (C. C. A. 2, 1934). The Court there held that to support the claim of disclosure in the abandoned application, it must appear that there was a complete disclosure. The critical question is—Could the claims in suit have been properly issued on the original (abandoned) application?

Realizing the properly applicable law, the Trial Court succinctly and aptly disposed of Petitioner's contention by the following:

Finding of Fact No. 8 (A. 773):

> "8. The claims in suit do not find adequate support in the disclosure of the abandoned Leblanc application, Serial No. 742,966, filed April 21, 1947, to have been properly issued on the specification of said abandoned Leblanc application for the reason that every such claim in the original and reissue patent recites three hinge rods with various mechanisms connected to them, whereas the abandoned application fails to show or describe three hinge rods. The oath of the original Leblanc patent in suit is an oath for an original application and not for a continuation, or continuation-in-part application and does not refer to said abandoned application."

Conclusion of Law No. 4 (A. 776):

> "4. The Leblanc abandoned application, Serial No. 742,966, does not afford a proper basis for any of the claims of the original patent here in suit. Said original patent is not entitled to the filing date of said abandoned application but must stand on its own filing date of August 19, 1950."

There clearly is no error therein. The Court of Appeals did not disturb such finding and conclusion.

The Decision That Respondent Has Intervening Rights Was Eminently Correct.

Respondent agrees that the first sentence of Paragraph 2, Title 35 U. S. C. A. Sec. 252 is mandatory. The second sentence of that paragraph confers discretion upon the Court to provide such relief as equity and good conscience require. *Rohm & Haas Company* v. *Chemical Insecticide Corporation et al.*, D. C. Del., 171 F. Supp. 426; 120 U. S. P. Q. 435 (1959) (apparently not appealed).

The Court of Appeals exercised its discretion in holding "Equity dictates that plaintiff may not now disturb such intervening rights acquired by defendant." (Decision,

p. 7; 310 F. 2d 454); after finding substantial support in the record for the Trial Court's decision to the same effect.

Contrary to Petitioner's contention, respondent finds nothing whatever in the decision of the Court of Appeals to indicate that the second sentence of Paragraph 2, Title 35 U. S. C. A. Sec. 252 was considered by the Court to be mandatory.

The Court of Appeals correctly relied upon the doctrine of *Sontag Stores Co.* v. *Nut Co.*, 310 U. S. 281, 294 (1940). But Petitioner herein contends respondent placed no reliance on the Leblanc original patent and therefore the equities in the *Sontag* case do not exist here. That is erroneous for two reasons.

First, respondent did rely on the original Leblanc patent, having consulted its attorneys as to whether it was infringing, whether it should continue to manufacture the accused clarinet or what it should do. And respondent then continued the manufacture and sale of the accused instruments on advice of counsel and spent money to improve its tooling and to promote the product (A. pp. 327-330).

Second, the Statute does not even require reliance on the original patent. In the second paragraph of 35 U. S. C. A. Sec. 252, "prior to the grant of the reissue" twice appears and "before the grant of the reissue" twice appears. Where there is no infringement of a valid claim carried over into the reissue, equity only requires, in order for one to have continuing intervening rights that such one should have made "substantial preparation" for the manufacture of the accused structure *before the grant of the reissue.*

Since the enactment of the Statute respecting intervening rights, it was held by the District Court of the Eastern District of Kentucky that intervening rights are a matter of equitable defense, relying on the *Sontag* case. On facts

quite similar to those here present, that Court recognized that in its discretion a Court may provide for the continued manufacture, use or sale of a device, in effect granting a license to the defendant, and so held. *Fred Gerhardt et al. v. Kenneth Kinnaird et al.*, 162 F. Supp. 858; 117 U. S. P. Q. 474 (1958) (apparently not appealed).

CONCLUSION.

The questions presented by the Petitioner are moot in that their consideration would not be dispositive of the controversy. The questions present nothing that has not already been fairly and fully considered and decided by both the Trial Court and the Court of Appeals. The Petitioner has presented no question of such public interest as to justify a review by this Court. The Court of Appeals, in deciding legal questions involved, properly applied principles laid down by this Court which were not altered or modified by the 1952 Patent Act.

It is therefore urged that the Petition be denied.

Respectfully submitted,

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